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Supreme Court of the United States

OCTOBER TERM, 1946

No. _____

THE FOXBORO COMPANY

Petitioner-Plaintiff

v.

TAYLOR INSTRUMENT COMPANIES

Respondent-Defendant

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

The Foxboro Company, petitioner v. *Taylor Instrument Companies,* respondent, respectfully prays for writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit to review the judgment of that Court pursuant to its opinion filed on July 25, 1946 (157 F. 2d 226; Plf. R. 1545) and denial, September 12, 1946, of the timely petition for rehearing (157 F. 2d 234; Plf. R. 1583). This judgment reversed that of the District Court of the United States for the Western District of New York. The judgment of the District Court was in favor of the plaintiff-petitioner, The Foxboro Company (58 F. Supp. 313; Dft. R. 657-677).

Jurisdiction to Review the Judgment

The Supreme Court has jurisdiction of this petition under Section 240(a) of the Judicial Code as amended by

the Acts of February 13, 1925, U. S. C. Title 28, Section 347(a), January 31, 1928, March 8, 1934 and June 7, 1934, and under U. S. C. Title 28, Section 350. The effective date of the entry of the judgment is September 12, 1946, within three months last past.

Reasons for the Writ

By its judgment the Circuit Court of Appeals for the Second Circuit has decided against The Foxboro Company, the plaintiff-appellee, because of what the petitioner for certiorari respectfully submits to be four errors of law in matters of general public importance and in conflict with the decisions of the Supreme Court and in conflict with the decisions of other Circuit Courts of Appeal, namely:

1. The Court of Appeals for the Second Circuit has based its decision on an erroneous assumption that the Supreme Court in recent decisions has revolutionized the law determining the boundary between invention and skillful application, whereas these decisions reaffirm the existing law. The most recent conflicting decisions in the Circuit Courts of Appeal are these:

> The First Circuit (*Brown & Sharpe Mfg. Co.* v. *Kar Engineering Co.*, 154 F. 2d 48, 51, 52), decided March 14, 1946, that "In *Anderson Co.* v. *Lion Products Co.*, 1 Cir., 1942, 127 F. 2d 454, 457, and *Bellavance* v. *Frank Morrow Co.*, 1 Cir., 1944, 140 F. 2d 419, 423, although not necessary to our decisions, we indicated that we inclined to the view that the *Cuno* case set a higher standard for invention. Now, however, we think that view mistaken. (Par.) In the second place later decisions of the Supreme Court indicate, we think unmistakably, that all that was intended in the *Cuno* case was a restatement of the classic test."
>
> The Second Circuit (*Foxboro Co.* v. *Taylor Instrument Cos.*, 157 F. 2d 226, 234), decided September 12, 1946, that "Finally, when all else is said, we cannot ignore the change in recent years in the standard of invention adopted by the Supreme Court. It is as idle to pre-

> tend that there has been no change (*In re Shortell,* 142 F. 2d 292, 31 C. C. P. A., Patents, 1062), as it would be to protest against it; and it is as much the duty of a lower court to give effect to it, as it is its duty to give effect to any other of the decisions of that court. We are to dispose of the question of invention, so far as we can divine, as we think the Supreme Court would dispose of it; and, once the cloud of complicated scientific theory, with which it has been surrounded, is blown away, and the issues are bared as they really are, we have no doubt that that court would hold the claims invalid. Judgment reversed; complaint dismissed." (Plf. R. 1558)

This conflict is of vast public importance. This is set out in more detail later.

2. The Court of Appeals for the Second Circuit, learned and experienced in law and wholly inexperienced in planning, building and operating machines for automatic temperature and pressure control at fractional degrees in ranges of many hundreds of degrees, has substituted its judgment, not of law but of pure fact on the question of invention (*Williams Co.* v. *United Shoe Machinery Corp.,* 316 U. S. 364, 367), for that based upon the oral evidence of men experienced in planning, building and operating such machines, unseen by the Court of Appeals and seen, heard and believed by the judge of the District Court who decided this question of fact on the evidence in the case. Such a reversal is in conflict with many uniform decisions of the Supreme Court and of other Circuit Courts of Appeal (*Adamson* v. *Gilliland,* 242 U. S. 350, 353; *Stilz* v. *United States,* 269 U. S. 144, 147; *McCaughn* v. *Real Estate Co.,* 297 U. S. 606, 608; *Hazeltine Corporation* v. *General Motors Corporation,* October 19, 1942, C. C. A. 3d, 131 F. 2d 34, 37).

3. The Circuit Court of Appeals for the Second Circuit in its decision rejects "the industry's acceptance of these machines as any evidence whatever that Mason's claims were valid" (157 F. 2d 233, 234; Plf. R. 1557). This is in

conflict with uniform decisions of the Supreme Court and of other Circuit Courts of Appeal. One of the latest of these (*Goodwin* v. *Borg-Warner Corp.*, July 1, 1946, C. C. A. 6th, 157 F. 2d 267, 273) is that "The rapid and widespread acceptance of his device is evidence to be considered on the question of invention".

4. The Circuit Court of Appeals for the Second Circuit has decided as a fact that in this art "the tempo has been . . . swift" (157 F. 2d 234; Plf. R. 1558). This decision is based exclusively on patents put before the Court in an attempt to show anticipation. The decision conflicts with the oral testimony of the witnesses seen, heard and believed by the judge of the District Court who decided this question of fact on this evidence, as to which there was no conflict. It showed that the need for this invention and the search to achieve it had continued over many years. The decision conflicts with the uniform decisions of the Supreme Court and of other Circuit Courts of Appeal, deciding the weight to be given by an appellate court, not seeing and hearing the witnesses, to the decision on a question of fact made upon that evidence by a judge who did see, hear and believe the witnesses.

The Invention as Found in Fact by the District Court

(Dft. R. 678-689, 657-677)

The Foxboro Company, the plaintiff, owns United States letters patent, reissue No. 20,092, granted September 1, 1936 to Clesson E. Mason, for a pneumatically operated proportioning controller and a pneumatically operated proportioning-plus-reset controller, for new combinations of old elements, disclosing sufficiently to enable a person skilled in the art to construct such a machine (R. 678). It is for controlling temperature processes in the oil and chemical industries by regulating fuel flow in response to process temperature behavior. It produces effectively accurate proportional changes in an operating output pressure in

response to changes of the measuring element sensing the temperature behavior. It may be operated by measuring elements capable of exerting only a very weak force (R. 679). The proportioning-plus-reset controller includes the elements of the proportioning controller and in addition a reset motor opposing the proportioning motor (R. 679). The machines and their operation in fact are found in detail (R. 678-680, 658, 659).

Prior to Mason's invention there was no proportioning controller and no proportioning-plus-reset controller universally applicable to all types of processes; nor any controller for difficult processes and capable of controlling such conditions as temperature, chemical concentration, and the like, to which conditions only low power measuring elements could respond (R. 680, 681).

Many processes are not adapted to produce practical operation of powerful measuring elements, for powerful measuring elements are not sufficiently sensitive to such conditions (R. 681).

Prior to Mason's invention there existed no accurate proportioning controllers and no accurate proportioning-plus-reset controllers which could be operated by a weak measuring element (R. 681).

Beginning about 1920 was the advent of difficult and complicated manufacturing processes (particularly in the fields of oil and chemical manufacture) for which there were no available adequate controllers for automatic control. Various attempts were made to meet the need during the ensuing ten years and without success until Mason's invention did so (R. 682-684, 657, 662).

Although placed on the market in a period of business depression, the device met with commercial success and the sales increased rapidly from year to year without the aid of special advertising or sales promotion (R. 684, 662, 663, 675).

These inventions solved control problems that had long confronted industry and which many inventors had tried to solve and had failed. The inventions were an important

advance in the art of automatic control and are inventive and patentable combinations (R. 665, 685).

After the plaintiff's invention came on the market the defendant put on the market an infringing device (R. 685-689, 663-665).

None of the patents introduced by the defendant anticipated Mason's invention (R. 689, 670-671).

Claims 10 and 13 are definite (R. 675). They distinguish over the prior art (R. 675). They adequately describe Mason's invention (R. 675).

Mason's invention was an important advance in the application of controllers to commercial processes (R. 662).

It constitutes a landmark invention of the present century and has wholly altered the course of development in many industries (R. 662).

It was adopted by leading manufacturers in this country and abroad, attesting to its outstanding practical performance and success in solving the difficult problems of automatic control (R. 663).

The opinion of the Circuit Court of Appeals starts by referring to the opinion in the District Court for the general nature of the invention (157 F. 2d 227; Plf. R. 1545) and goes on with a description of the detailed resemblances between the different elements of Mason's combination and earlier elements (pp. 228-233; Plf. R. 1548-1556) and, without any adequate discussion of the novelty in the combination of these as set out in the claims, concludes that there was no invention, for the reasons, erroneous, it is respectfully submitted, stated at the outset of this petition (157 F. 2d 234; Plf. R. 1558). In this the Court of Appeals has failed, it is respectfully submitted, to give due weight in the application of the patent statute, to the long established principle implicitly recognized by the Supreme Court, November 18, 1946, in *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U. S. , that "We are not persuaded that the public and those affected by patents should lose the protection of this statute merely because the patented device is a combination of old elements".

The Uncontroverted Evidence Supports the Finding of Fact of Invention by the District Court

It is assumed that the Supreme Court will not tolerate in this petition an extended reference to the evidence. The evidence is ample and indisputable that Mason's conception, fully set out in the claims, more particularly 10 and 13, was of a device which could not be reached by skill in the art without inventive imagination and application.

This was oral evidence by experienced planners and operators in this art, seen, heard and believed by the judge of the District Court.

The references are to the pages of that testimony in the Appendix of the Appellee.

The controller industry began looking in 1920 (pp. 8, 9). With unsatisfactory results until 1930 (p. 9).

The attempts to solve the problem since 1920 (p. 11) and extending to page 1068.

Mason's description of the difficulties, and of the invention which solved them (pp. 10-84, 109-214, 291-709, 921-923, 1013-1068). Hall's testimony to the impossibility in practice of getting a satisfactory result without Mason's device (pp. 84-109). Sperry's testimony confirming this (pp. 241-290, 975-997). Haywood's testimony to the impracticability of the former devices and the efficiency of the plaintiff's (pp. 709-734). Sachse's testimony of the same import (pp. 734-773). Grebe's (pp. 773-780). Webb's (pp. 780-799). Bright's (pp. 799-821). Bosomworth's (pp. 821-832). Mooney's (pp. 832-844). Laird's (pp. 844-865). White's (pp. 865-878). Sullivan's (pp. 878-888). McCulley's (pp. 888-921). Hardman's (pp. 928-944). Yoxall's (pp. 944-964).

This upwards of one thousand pages of testimony was of men practising in this field. It was wholly believable. It was believed by the judge of the District Court. It showed the need of this device over a period of many years. It

showed the efforts of intelligent experts to find a solution. It showed the complete failure until Mason got the idea.

Such testimony that this could not be done without invention is much more convincing than the decision of any judge, howsoever learned in the law and not experienced in this highly technical field, that a practical expert could have got this without inventing it.

The opinion of the Circuit Court of Appeals in reality substitutes an assumption by a court not practically experienced in this field for the evidence in the case, believed by the judge who saw and heard the witnesses. Even that which may look easy after it has been invented and described, if it had been easy, would have been produced in the long years of effort of experts if it had been so easy as not to require invention.

The judge of the District Court who saw and heard these men perceived the fact and reached his judgment thereon.

On these facts the petitioner represents, for the reasons more fully described in the brief filed herewith and made a part hereof, that the four errors of law claimed above in matters of general public importance and in conflict with the decisions of the Supreme Court and of other Circuit Courts of Appeal were made by the Circuit Court of Appeals for the Second Circuit.

The petitioner presents herewith a certified copy of the entire record in this case, including the opinion of the Circuit Court of Appeals for the Second Circuit, and appends hereto a brief.

WHEREFORE, the petitioner respectfully prays that a writ of certiorari be issued to the Circuit Court of Appeals for the Second Circuit to the end that said cause may be reviewed and determined by this Honorable Supreme Court as provided by law, and that the said decision of the said Circuit Court of Appeals be reversed and the final judgment of the District Court for the Western District of New York for the petitioner be reinstated and that your peti-

tioner may have such other and further relief in the premises as to this Honorable Supreme Court may seem just and proper.

THE FOXBORO COMPANY

By its Attorneys,

EDWARD F. MCCLENNEN
EDWARD G. CURTIS
CHARLES C. LADD

We, counsel for the petitioner, hereby certify that the foregoing petition is presented in good faith and not for the purpose of delay, and that in our opinion the case is a proper one for the issuance of the writ of certiorari prayed for.

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December 2, 1946.

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI

In order to make the petition summary and short the petitioner has omitted reference to the features of this case as to which the decision of the Circuit Court of Appeals was in the petitioner-plaintiff's favor and matters not pertinent to the four errors of law claimed. The petitioner submits that the judgment of the District Court was right in sustaining as an invention claims 10 and 13 of reissue patent No. 20,092, granted September 1, 1936 to Clesson E. Mason and owned by The Foxboro Company, the plaintiff.

The petitioner presents for the consideration of the Court the four errors claimed.

1. The conflicting decisions among the Circuit Courts of Appeal as to the interpretation of the opinions of the Supreme Court defining the boundary line of invention.

In the First, Seventh and Eighth Circuits and in the Court of Customs and Patent Appeals the Court of Appeals has decided that the Supreme Court in its recent opinions has reaffirmed the law as it certainly was up to the decision in *Cuno Corp.* v. *Automatic Devices Corp.*, November 10, 1941, 314 U. S. 84.

In the Second Circuit and in the Sixth Circuit the Court of Appeals has held that the Supreme Court changed the law which theretofore had furnished the boundary line of invention.

In the Sixth Circuit the Court of Appeals has not adopted the new test devised by the Second Circuit. This latest test is that nothing is invention which is preceded by a number of trials and failures. With this test the Second Circuit now eliminates as unpatentable the largest class of advances that are recognized by the other circuit courts and by the Supreme Court as entitled to patent protection.

In the Third, Fourth, Fifth, Ninth and Tenth Circuits the general question appears to be still at large.

The gravity of this conflict on a question of so great public importance is apparent. Whichever is the sound interpretation of the opinions of the Supreme Court on this boundary question, the need of a decision of that Court ending the conflict is great. No otherwise can it be done.

The peril is to the adopter of a device tendered in the market, to the inventor in search of a novel means of meeting a need, to the lawyer advising on the patentability of the device, to the applicant for a patent, to the formulator of claims, to the administration in the patent office, to the lawyer advising whether a patented device may be used, and to the courts called upon to exercise judgment on this question.

The petitioner has lost its patent because circumstances required suit in the Second Circuit, and is aggrieved. If the suit might be in the First Circuit the petitioner would have its patent, as sustained by the judge of the District Court in the case at bar.

It is respectfully urged that the Supreme Court should grant the writ irrespective of what the decision in the case is to be, and so to end this conflict.

The pertinent decisions are:

In the First Circuit, *Brown & Sharpe Mfg. Co.* v. *Kar Engineering Co.*, March 14, 1946, 154 F. 2d 48, certiorari denied June 10, 1946, 328 U. S. , 66 S. C. R. 1377; in the Seventh Circuit, *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, January 20, 1943, 132 F. 2d 812, 817; in the Eighth Circuit, *Sbicca-Del Mac* v. *Milius Shoe Co.*, November 18, 1944, 145 F. 2d 389, 394; in the Court of Customs and Patent Appeals, *In re Shortell*, April 4, 1944, 142 F. 2d 292, 296; in the Second Circuit the case at bar, 157 F. 2d 226, 234; in the Sixth Circuit, *United States Gypsum Co.* v. *Consolidated Exp. Met. Co.*, October 6, 1942, 130 F. 2d 888, 892, declining to go the length taken in the Second Circuit first stated and applied in 1942, and applied in the case at bar.

In this length of restriction the Second Circuit appears to be alone. This length was reached in the Second Circuit after the Cuno case by deciding that the Supreme Court has shown an increasing disposition to raise the standard of originality necessary for a patent, and by adopting the new test (*Picard* v. *United Aircraft Corporation,* 128 F. 2d 632, 636 and, *F. A. Smith Mfg. Co. Inc.* v. *Samson-United Corp.,* Aug. 1942, 130 F. 2d 525, 531, C. C. A. 2).

Without hesitation it is to be said that the Supreme Court would not indulge a disposition to change the law enacted by the Congress within the provisions of the Constitution, and surely not to exclude an important class of inventions from protection under the law. That Act, 35 U. S. C. Section 31, provided two classes of persons who could obtain a patent, namely, one who has "invented" and the other, one who has "discovered" any new and useful machine or improvement therein.

"Invented" as used in the statute and "inventors" as used in the Constitution had a generally accepted meaning when first used. That meaning has not changed. True, a device which met that meaning at one time, later becomes so much common property that a repetition of it is not invention. The standard of originality has not changed. The Supreme Court has given no indication of a change.

The opinion in *Cuno Corp.* v. *Automatic Devices Corp.,* 314 U. S. 84, reiterates the time honored principle that (90) "if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art". (91) "That is to say, the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling". The context gives no suggestion that the attention-arresting phrase "flash of creative genius" is used to mean anything except more than "merely the skill of the calling". The decisive language of the Court (88) is that "The Mead device was not the result of invention but a 'mere exercise of the skill of the calling', an advance 'plainly indicated by the prior art' ".

In this decisive language there is nothing to indicate that for invention it is necessary to do more than to exceed "the skill of the calling".

The later decisions of the Supreme Court give no support for any requirement except that the device has not been the product of a "mere exercise of the skill of the calling".

In *Sinclair & Carroll Co., Inc.* v. *Interchemical Corp.*, 325 U. S. 327, 330, the Supreme Court reiterates the long established principle and cites for this standard definition seven decisions, beginning with *Hicks* v. *Kelsey,* 18 Wall. 670, and ending with the very case under discussion, *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 90. That is the proposition for which the Supreme Court cites the case under discussion. It does so May 21, 1945.

It is respectfully submitted that the Circuit Court of Appeals for the Second Circuit has made, erroneously, additions to the true significance of the opinions of the Supreme Court and that the conflict with the other Circuits which the Second Circuit has thereby created should be ended by a decision of the Supreme Court.

2. The error in reversing a finding of fact of the District Court based on ample supporting oral evidence.

Whether a device is an invention in that its production goes beyond a mere exercise of the skill of the calling is a question of fact (*Williams Co.* v. *United Shoe Machinery Corp.*, 316 U. S. 364, 367). The facts of the calling are to be determined by the evidence of those experienced in the calling. The decision of a judge who heard that evidence and saw the witnesses should prevail, if the evidence permits it, over a decision of a Court of Appeals not experienced in that calling and which did not see or hear the witnesses. (*Adamson* v. *Gilliland*, 242 U. S. 350, 353; *Stilz* v. *United States*, 269 U. S. 144, 147; *McCaughn* v. *Real Estate Co.*, 297 U. S. 606, 608; *Hazeltine Corporation* v.

General Motors Corporation, October 19, 1942, C. C. A. 3d, 131 F. 2d 34, 37.)

In the thousand pages of oral testimony there is abundant evidence that Mason's device was beyond ascertainment by the exercise of the skill of the calling. The urgent need for such a device had been on for more than ten years. Those skilled in the calling had tried to meet it. All those skilled in the calling had failed until Mason conceived of a novel approach by a novel combination which gave immediate operating success and consequent unstimulated commercial success where those skilled in the calling had failed.

This new conception was an inspiration, a flash of genius, in short an invention.

It was not a whittling, a filing, a polishing, a reshaping, a readjustment, an improving, a perfecting within the power of the unimaginative, uninventive man skilled in the calling. It was the novel combination of a member in a relation not before thought of in the diligent efforts of skilled men over a period of more than ten years, of urgent need.

The judge of the District Court gave his verdict based on this abundant evidence (R. 678-685, 662, 675).

It is respectfully submitted that it was an error to substitute a contrary finding of fact by the Court of Appeals for the finding of fact of the judge of the District Court, who had seen, heard and believed the witnesses. The decision is in conflict with those above cited and others in the Supreme Court and the Courts of Appeal of other Circuits.

3. The error in rejecting the industry's acceptance of these machines as any evidence whatever that Mason's claims were valid.

The judge of the District Court found that the "subject matter of the patent is extremely intricate and difficult to comprehend" (R. 671). In this intricate mechanism Mason combined motor devices in a combination, the effect of which was for the first time to get accurate immediate control action while at the same time imposing no force on the

measuring element. This novelty brought operating success at once in contrast to failures at the hands of the most skillful in the calling who had been seeking over years to meet a long time observed need.

The success was directly attributable to the novel combination claimed. Sachse (S. O. Co. of Ohio) at Plf. R. 748 and 763; Grebe (Dow Chemical Co.) at Plf. R. 779; and Bright (Eastman Kodak Co.) at Plf. R. 816, 819, described difficult temperature and flow problems encountered in their respective industries, stated that these problems were not solved by prior controllers, and that they were solved by the Mason controller because it gave accurate proportioning and reset control actions when applied to the difficult processes they described. Mason, Plf. R. 123, 128-130, 135, 136, 347, 384, 385, 532, described each of the elements and the manner in which they coact to produce accurate proportioning and reset action. Mason's claims 10 and 13 recite the very combinations of elements which he testified produce the accurate proportioning and reset actions that Grebe, Sachse and Bright said were responsible for the success of Mason's instrument.

The operating success immediately brought commercial success in a market in a period of business depression and without the aid of special advertising or sales promotion (Dft. R. 684, 662). These facts are found by the District judge to be the facts. They are not open to reasonable controversy. The Court of Appeals, after describing what may at large account for success, in ways foreign to the evidence in this case and to the findings of fact of the judge of the District Court thereon, decides that "We therefore reject the industry's acceptance of these machines as any evidence whatever that Mason's claims were valid" (157 F. 2d 233, 234; Plf. R. 1557). This decision is in conflict with decisions in other Circuits of long standing and repeated as late as this year (*Goodwin* v. *Borg-Warner Corporation,* C. C. A. 6th, 157 F. 2d 267, 273; *Sbicca-Del Mac* v. *Milius Shoe Co.,* November 18, 1944, C. C. A. 8th, 145 F. 2d 389, 395).

It is respectfully submitted that when resolving the question of fact, whether in this complicated mechanism there was a novel combination, and when it has been found that the novel combination was an important practical advance which was the cause of the adoption of the device by leading manufacturers in this country and abroad (Dft. R. 662, 663), and when there was no evidence that this was due to sales promotion and a finding that it was not (R. 684, 662), and when it is found that these inventions were what solved the control problems (R. 684), and when there was no evidence that the success was due to any excellence of design or fineness of workmanship or existing repute of the maker, it is a serious error of law to reject the industry's acceptance of these machines and to conclude as a fact, contrary to the finding of the judge of the District Court, that this acceptance was not due to the novelty of the invention found in fact by the District Court.

4. The error in the finding of fact by the Court of Appeals as to the tempo of the art.

Manifestly, the tempo of this art was a matter not of law but of fact. The Court of Appeals, considering the patents laid before it in the effort of the defendant to show anticipation, decided in fact that this tempo was swift (157 F. 2d 234; Plf. R. 1558). This sets aside the finding of fact of the judge of the District Court that the tempo had been so slow that it required more than ten years of urgent need and skilled unsuccessful effort to meet it before Mason's invention did it (Dft. R. 682, 685).

These unsuccessful skillful efforts had reached the point of full patent application disclosures. The best work of over ten years had failed. This was not a swift tempo in advancing skill of the calling.

There was nothing swift unless it be the flash of genius, the inspiration, the conception by Mason which he rapidly reduced to practice and to acceptability by practical manufacturers who had long sought and needed this invention. The decision in substituting this finding by the Court of

Appeals for the finding of fact by the judge of the District Court, who saw, heard and believed the witnesses, is in conflict with the decisions of the Supreme Court and in other Circuits cited under division 2 above, which established that the findings of fact of the District Court, warranted by the evidence, should prevail in the Court of Appeals.

Conclusion

The plaintiff's petition deserves to be granted.

Respectfully submitted,

EDWARD F. MCCLENNEN,
EDWARD G. CURTIS,
CHARLES C. LADD,
Counsel for the Petitioner.

December 2, 1946.

Supreme Court of the United States

OCTOBER TERM, 1946

No. 740

THE FOXBORO COMPANY,
Petitioner-Plaintiff,

v.

TAYLOR INSTRUMENT COMPANIES,
Respondent-Defendant.

REPLY BRIEF FOR PETITIONER

The petitioner asks leave to present this Reply Brief, limited to pointing out errors in the Brief for the Respondent.

1. The conflicting decisions among the Circuit Courts of Appeal.

The Respondent's Brief implicitly, if not expressly, admits this conflict and asserts (p. 2) that the decision in the case at bar was not rested on the asserted claimed change in the standard of invention adopted by the Supreme Court. This repudiates the statement by the Court itself of the basic reason for its decision as to Mason's invention, namely:— "So far as he is concerned, his work is merely the latest refinement of a continuous progress, proceeding by trial and error", 157 F. (2d) 233 (R. 1557). No more

significant language could be chosen to express that this decision is based on the test now applied in the Second Circuit: that nothing is invention which is preceded by a number of trials and failures. The testimony (R. 1022-1030) showed that the work of the prior patentees had not made progress toward Mason's invention but, on the contrary, away from it (R. 1577, 1578). The District Court had found in fact that the prior devices lacked the control of the difficult processes which was furnished by Mason's novel combination (Dft. R. 670, 671). The opinion of the Circuit Court of Appeals is rested squarely on its interpretation and on the superlative significance which that Court has alone attached to the "flash of genius" words of the Supreme Court. The Court of Appeals for the Second Circuit has created this latest test, that nothing is invention which is preceded by a number of trials and failures. It has used the most exact words in this opinion to show that it is applying to this case that test. That test, which does not prevail in the other Circuits, is the reason why the decision in this case in the Circuit Court of Appeals, overruling the District Court, was against the plaintiff.

2. The reversal of findings of fact of the District Court.

The Respondent's Brief (pp. 2, 3, 6, 9 and 11) fails to meet the Petitioner's Brief (pp. 14, 15). The District Court in its decision was not actuated by the mere skill of the linguist in reading the prior patents; it was dealing in the light of the testimony with the significance of those patents as applied to practical operations. The testimony disclosed failure to meet the urgent need until the combination set out in the claims was conceived and applied by Mason. The Court of Appeals in its opinion makes comparison between

individual earlier patents and some of the component parts of Mason's combination invention. It does not deal with the fact that there was no prior conception of that combination and that it was that novel combination which produced the emphatic success. The Respondent's Brief points out the very language of the opinion of the Court of Appeals which the petitioner submits was erroneous, in that it announced facts contrary to the findings of fact of the District Court. Those facts were amply supported by the evidence before the District Court, on which the Court of Appeals makes no comment. A mere cloistered interpretation of documents is not to be substituted wisely for the testimony of witnesses, seen, heard and believed, which gives significance in practical operation to the documents.

The Respondent's Brief says (p. 8) that the trial court was "apparently * * * befuddled". The petitioner asks that the trial court be not convicted of this by the Supreme Court before hearing argument and the extensive testimony cited at page 7 of the petition. On this testimony the trial court found that the devices of the three patents could not control difficult processes and did not have Mason's novel combination which gave the accurate proportioning action and reset action (R. 670, 671).

The opinion of the District Court is not to be ignored in determining the findings of fact which it made. *Hazeltine Corporation* v. *General Motors Corporation,* 131 F. (2d) 34, 37, C. C. A. 3, 1942.

The assertion of the Respondent's Brief (p. 7) that the Court made "no true finding of fact" with respect to the prior art is an assertion which asks the Court, without considering the evidence in the record, to decide that the finding of fact of the District Court was not a true finding.

This cannot be done without considering the entire evidence and emphatically that at R. 241-290, 975-997, 1022-1030. One of the causes of the error in the Circuit Court of Appeals, it is respectfully submitted, was the failure to give consideration to this evidence and to the findings of fact in the District Court so amply supported by it.

It is submitted that the Brief for the Respondent deviates from the record and does not meet at a single point the Petition and Brief for the Petitioner.

Respectfully submitted,

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Supreme Court of the United States

October Term, 1946

No. 704 740

THE FOXBORO COMPANY,

Petitioner,

vs.

TAYLOR INSTRUMENT COMPANIES,

Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Supreme Court of the United States

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No. 704

THE FOXBORO COMPANY,

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vs.

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BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

The petition for writ of certiorari and supporting brief nowhere describe the patent in suit, or the supposed invention that it contains; much less does either discuss the prior art which the Court of Appeals found to leave no room for invention in the claims in issue; but, by purely abstract statements seek to show that that Court made a decision that should be reviewed by this Court. No effort is made to analyze the huge record that is tendered.

The decision below is reported, 157 F. 2d 226.

The petition and supporting brief set forth four alleged reasons for the allowance of the writ which will be discussed seriatim herein. It will be shown that no reason for allowance exists and that, therefore, the petition should be denied.

1. Petitioner's First Point.

The first reason (Pet. 2-3) sets forth that there is a conflict between the decision in the instant case by the Court of Appeals for the Second Circuit and those of the First, and other circuits, because the Second Circuit Court "based its decision on an erroneous assumption that the Supreme Court in recent decisions has revolutionized the law determining the boundary between invention and skillful application".

We shall not attempt to refute this alleged conflict between the circuits because the Court of Appeals for the Second Circuit, in this case, did not rest its decision on "the change in recent years in the standard of invention adopted by the Supreme Court" as urged by petitioner (Pet. 2, last two lines). While the Court, in the last paragraph of its opinion, did make the statements quoted on the last three lines of page 2 and top of page 3 of the petition, yet it should be noted that it began that paragraph with these words (R. 1558): "Finally, when all else is said, we cannot ignore the change in recent years * * *". This shows clearly that it was an added reason and not the main reliance for the holding of invalidity.

Prior to that last paragraph the court had set forth cogent reasons for that holding having nothing to do with the so-called change in the test of invention by the Supreme Court. The Court actually held the patent in suit invalid because, while there were some differences in its disclosure over the prior art, yet those points of distinction *were not included in the claims* which themselves were not distinguishable over the prior art. This is shown by the follow-

ing quotation from the opinion of the Court of Appeals (R. 1555-6):

> "That there are differences between the disclosures of these three prior patents and Mason's is true, but these are irrelevant except in so far as they appear in Mason's claims, and *they do not appear there, except the element of an 'elastic fluid' in all but the first three; and Wünsch disclosed 'air' or a 'gas' as an alternative to 'oil'.** We should have no warrant for limiting the claims by the elements of the disclosure which they do not include, even if the elements were new. A patentee who claims broadly must prove broadly; he may not claim broadly, and recede as he later finds that the art unknown to him has limited his invention. That is the chance he must take in making broad claims; if he has claimed more than he was entitled to, the statute does give him a locus poenitentiae, but he must seasonably disclaim the broad claims in toto. He may not keep them by interpretative limitation; he must procure new claims by reissue. This is the significance of *Milcor Steel Co.* v. *George A. Fuller Co.*, 316 U. S. 143. This applies with exceptional force to the case at bar, in which Mason not only had his day in the Patent Office, but *twice thereafter amended his claims; first, by his disclaimer, next, by reissue.* It is true that Mason's single figure discloses no 'needle valve' in the pipe, '43', and the flapper, '35', as free from any opposing force, yet from start to finish neither the claims nor the specifications so much as intimate that either of these features was an element of the invention. It would be enough to prevent such an interpretation of the claims that, after so many efforts the claims remained silent upon these details, even if the specifications had mentioned them; but the interpretation becomes doubly impossible when we remember that no invention can be saved by features which appear only in the figures, and are not men-

* Emphasis supplied unless otherwise noted.

tioned in the text. *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 60; *Vickery* v. *Barnhart*, 118 Fed. (2) 578, 585 (C. C. P. A.)." * * *

> *"For these reasons, merely as a matter of interpretation, we could not properly save the claims by incorporating into them those elements upon which the plaintiff relies to distinguish from the prior art; and even if we could, it would not save them."*

Thus it appears that the last paragraph of the opinion, upon which petitioner bottoms its first point, is nothing more than another reason for the reversal, philosophically discussed.

Cases in which statements by the Courts of Appeals similar to that here relied upon, have been made the basis of application for review by this Court and denied, are

Picard v. *United Aircraft Corp.*, 128 F. 2d 632, 636 (C. C. A. 2), certiorari denied 317 U. S., at page 651;

Bellavance v. *Frank Morrow Co.*, 140 F. 2d 419, at pp. 422-3 (C. C. A. 1), certiorari denied, 322 U. S. 472;

U. S. Gypsum Co. v. *Consolidated Co.*, 130 F. 2d 888, 892 (C. C. A. 6), certiorari denied, 317 U. S. 698.

On page 14 of its brief, petitioner cites *Sinclair & Carroll Co. Inc.* v. *Interchemical Corp.*, 325 U. S. 327, 330 in support of the principle that invention should be only more than the "mere exercise of the skill of the calling." In that case this Court independently construed the prior patents and patent in suit, just as the Court of Appeals did in the instant case. In the *Sinclair* case, the District Court held the patent invalid and not infringed. The Court of Appeals reversed both holdings, and this Court reversed the

Court of Appeals and held the patent invalid. It is interesting to note that this Court did not refer to the findings of the District Court and did not apply the principles of Rule 52 of the Federal Rules of Civil Procedure—for the obvious reason that the patent and the prior art were conceded facts which the Court could see for itself left no room for invention. This topic is discussed under the next heading.

2. Petitioner's Second Point.

The second point which petitioner raises is that the Court of Appeals "has substituted its judgment, not of law but of pure fact on the question of invention (citing cases), for that based upon the oral *evidence* * * * heard and believed by the judge of the District Court who decided this question of fact on the evidence in the case" (Pet. 3). Such reversal is asserted to be in conflict with many opinions of this and lower courts. This is argued at pages 14-15 of the supporting brief under the title "The error in reversing a finding of fact of the District Court based on ample supporting oral evidence".

Petitioner is in error in taking this position for the Circuit Court of Appeals did not substitute its judgment on a question of fact based on oral evidence for that of the Court below. As appears from the opinion of the Court of Appeals, its reversal is based on documents in the case, namely what the prior art patents and patent in suit clearly disclose. This is apparent from the discussion of what is clearly apparent on the faces of the Mason patent in suit (R. 1545) the prior Lindsay (R. 1548-50), Wingfield (R.

1550-2), and Wünsch (R. 1552-5) patents, leading to the conclusion:

> "That there are differences between the disclosures of these three prior patents and Mason's [the patent in suit] is true, but these are irrelevant except in so far as they appear in Mason's claims, and they do not appear there, except the element of an 'elastic fluid'* in all but the first three; and Wünsch disclosed 'air' or a 'gas' as an alternative to 'oil' * **" (R. 1555).

The Court of Appeals correctly went to the disclosure of the patent in suit and those of the prior patents, and made its own comparison to decide whether the patentee's structure was to be classified as a patentable invention or whether it was not. *Potts* v. *Creager,* 155 U. S. 597; *Heald* v. *Rice,* 104 U. S. 737, 749; *Singer* v. *Cramer,* 192 U. S. 265, 275; *United States* v. *Esnault-Pelterie,* 303 U. S. 26, 30. These authorities establish that not only when there is no substantial dispute either as to the devices of the prior art or as to what the patentee did, but also when the prior art and what the patentee did is clearly apparent to the appellate court from the record and exhibits, then it is for that Court to compare the alleged invention with the prior art and from that comparison to say whether the patentee's structure is to be classified as a patentable invention over

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* The idea of "elastic fluid" did not come into the claims until the filing on May 11, 1933 of disclaimer with respect to the original of the reissue patent in suit (Defdt.'s App. 399). This was two years and eight months after the filing of the Mason application on September 15, 1930 (Defdt.'s App. 296) and three months after the granting of the original Mason patent.

** The specification of the Mason patent in suit merely calls for "Fluid under pressure, such as compressed air * * *" (Defdt.'s App. 296, col. 1, lines 41-2) and the claims as originally issued cover *any* pressure whether oil, water or air (Defdt.'s App. 396).

the prior art or whether it is not. See *Hanovia Chemical & Mfg. Co.* v. *David Buttrick Co.*, 127 F. 2d 888 (C. C. A. 1). This is what this Court did in *Sinclair & Carroll Co. Inc.* v. *Interchemical Corp.*, 325 U. S. 327 (*supra*).

This rule applies all the more strongly in the instant case because the trial court made no true finding of fact below with respect to the prior art. It made only a general *conclusion* with respect to invention over the prior patents. The only place in the findings where the District Court dealt with the prior art patents, upon which the Court of Appeals based its reversal, is in the following finding:

> "58. The defendant cited and introduced evidence relating to the following prior art patents, publications and devices: Wingfield Br. Patent No. 254,469, Lindsay Br. Patent No. 218,370, Lindsay Br. Patent No. 234,194, Smoot 1,680,750, Wünsch 1,959,889, Frymoyer, 1,799,131, Mason 1,950,989, Trinks' Book, Hygrostat, Taylor Type P Controller, Taylor Type D Controller, Smoot Controller, Taylor Type 3R Controller, Taylor Type 27R Controller. None of them anticipates the inventions of Mason as disclosed in the patent. The inventions of Mason constitute patentable improvement and invention over the subject matter of all of the prior patents, publications or devices herein referred to." (Defdt.'s App. 689)

The above quoted conclusion falls into that category where the appellate courts are not bound by Rule 52 of the Federal Rules of Civil Procedure, but are free to decide themselves. *Himmil Bros. Co.* v. *Serrick Corporation*, 122 F. 2d 740 (C. C. A. 7); *Murray* v. *Noblesville Milling Co.*, 131 F. 2d 470 (C. C. A. 7); *Kuhn* v. *Princess, etc.*, 119 F. 2d 704 (C. C. A. 3); *State Farm Mutual Automobile Insurance Co.* v. *Bonacci*, 111 F. 2d 412, 415 (C. C. A. 8).

At the very end of its opinion, the Court below adverted to the plaintiff's mode of trying the case—which apparently had befuddled the trial Court—by saying "once the cloud of complicated scientific theory, with which it [*i.e.*, the patent] has been surrounded, is blown away, and the issues are bared as they really are, we have no doubt" (R. 1558) of its disposition.

Therefore we say the Court of Appeals was fully justified in the course it took to relieve the public of the incubus of an invalid patent.

3. Petitioner's Third Point.

Petitioner's third point is that the Court below, in its decision, rejects "the industry's acceptance of these machines as any evidence whatever that Mason's claims were valid" (Pet. 3). This statement was made by the Court of Appeals, but petitioner has lifted it out of its context thereby changing its meaning, and from that argues that the success "was directly attributable to the novel combination claimed" (Pet 16).

The Court, after a general discussion of success, mentioned factors other than novelty and value of the disclosure which might account for success. It then said (R. 1557):

> "In the case at bar let us, nevertheless, eliminate all such possible factors; let us suppose that it was only the differences between the disclosure of Mason and those of Lindsay, Wingfield and Wünsch, which for the first time made possible a machine acceptable to the art. We should still be as far as ever from any safe use of this evidence, for the *question is of the success to be attributed to that part of the disclosure which the claims have selected.*[1] Only in case we have

[1] See the discussion of petitioner's assertion with reference to success as related to the combination claimed, at page 19 hereof.

> some assurance that the success was here due to those factors by which the *claims differed from the prior art,* ought we take it as a criterion; and it would certainly be a gratuitous assumption to suppose that the industry's acceptance of these machines was due in any measure to those factors in the claims if indeed there are any. We therefore reject the industry's acceptance of these machines as any evidence whatever that Mason's claims were valid; and, being thrown back upon any advance over the art discoverable in them, we are at a loss to find any unless it be the gathering of factors which had all appeared before. When that occurs by a gathering from remote arts, it is often an index of much insight and perspicacity; but not when the combination is of factors to be found in the very field, and especially in so special a field as this; and certainly not when the tempo has been so swift as it was here" (R. 1557-8).

In the first place, commercial success can only be considered as supporting invention when doubt exists (*McClain* v. *Ortmayer,* 141 U. S. 419). The Court of Appeals neither expressed nor inferred doubt of validity.

In the second place, the Court of Appeals held that none of the differences of the Mason patent over the prior art appeared in the claims in suit (R. 1555). Thus, in the portion of its opinion last quoted, no success could be attributed to any differences over the prior art, which immediately brought the Court to considering the success as attributable to "the gathering of factors which had all appeared before" (R. 1557, bottom). Directly after this, the Court said (R. 1557, foot):

> "When that occurs by a gathering from remote arts, it is often an index of much insight and perspicacity; but not when the combination is of factors to be found in the very field, and especially in so special field as this; and certainly not when the tempo has been so swift as it was here."

It is because of this, and because there was no doubt of invalidity, that the Court of Appeals rejected any evidence of success to support validity, and in this it was upon absolutely sound ground—long since settled as indicated by the *McClain* case just cited.

We submit that this point does not stand analysis, and should be rejected.

4. Petitioner's Fourth Point.

The fourth point which petitioner attempts to make in support of its petition is that the Court of Appeals "has decided as a fact that in this art 'the tempo has been * * * swift' " and argues that "The decision conflicts with the oral testimony of the witnesses seen, heard and believed by the judge of the District Court who decided this question of fact on this evidence, as to which there was no conflict" (Pet. 4—argued pp. 17-8).

There was nothing to prevent the Court of Appeals from so holding in view of the undisputed facts that the prior patents to Lindsay, in 1925, Wingfield, in 1926 and Wünsch, in 1929—upon which it relied (R. 1548-52)—were quickly followed by the application for the patent in suit in 1930 (R. 1545). As that Court held "the law unsparingly charges him [the patentee of the patent in suit] with an acquaintance with all the earlier developments of the art" and that "his work is merely the latest refinement of a continuous progress, proceeding by trial and error" (R. 1557). The prior patents referred to were of course those which the Court of Appeals said contained the elements of the patentee's claims (R. 1555).

In addition, petitioner's point is wholly collateral since it makes no difference whether the tempo was swift or slow, because regardless of that the elements of the claims were all found in the three prior patents.

We submit that the point is wholly lacking in substance.

RESPONDENT'S POINTS

There are certain points not mentioned by petitioner which have a bearing upon the grant or denial of the petition.

5. The Mason Patent is Void for not Disclaiming All That Should Have Been Disclaimed.

This point was decided adversely to the defendant (respondent here) by the Court of Appeals, but *the Court did not consider the case in this Court controlling* on the facts, although it was pressed in the defendant's brief in the Court below. That is the case of *Marconi Wireless Telegraph Company of America* v. *United States*, 320 U. S. 1.

The facts at bar are these: The original patent was applied for September 15, 1930, and granted February 14, 1933 (Defdt.'s App. 296). On March 27, 1933, Frymoyer of plaintiff wrote to Swift of defendant charging infringement of the original of the patent in suit by its Fulscope-Dubl-Response Controller (Defdt.'s App. 324-5), which had been on the market since shortly before September 19, 1932 (Defdt.'s App. 33).

Swift immediately replied, March 30, 1933 (Defdt.'s App. 326) and advised Frymoyer of four prior patents

which negatived the novelty of the claims of the original patent. Frymoyer says he had never previously seen any of these prior patents (Pltff.'s App. 925) and the record shows that immediately recognizing their controlling importance he consulted with Miller, his patent attorney (Pltff.'s App. 926), and with the officers of his company. But he did not communicate with defendant.

After discussions with plaintiff's counsel of the cited prior patents (Exs. P-152-5, Defdt.'s App. 327-31), and as a result of them, a disclaimer was drawn up, signed and filed (Pltff.'s App. 926-7) May 11, 1933. Among other things there was disclaimed "*the subject matter" of* claim 3 of the original patent (Defdt.'s App. 399). That claim is identical with claim 4 of the original patent (claim 2 of the reissue in suit and relied on by petitioner, in the District Court as typical) except for the addition of the last four lines of claim 2 which are here printed in italics:

> "2. A fluid-pressure-operated control mechanism of the supply and waste valve type comprising a control couple, one element of which affords a port to atmosphere and the other a valve for said port, the relative approach and recession of said elements governing the pressure in the system, and means conjointly to control the relative position of said elements comprising a device responsive to the fluctuations of a variable condition which is affected by the controlled action, and a chamber subject to the controlled pressure having a part movable responsively thereto, *said chamber being adjustably movable as a whole and by such adjustment effecting movement and adjustment of one of said elements relative to the other*" (Defdt.'s App. 299, 396).

The drawing shows and the specification of the Mason patent (original, Defdt.'s App. 391—reissue, Defdt.'s App.

295) describes a *particular* way of securing adjustability of the nozzle relative to the flapper of the control couple, namely, "adjusting screw 49" (p. 1, col. 2, lines 36-7, Defdt.'s App. 296) so that the adjustment may be made *manually* for new conditions encountered. Without that mechanical feature adjustability is unobtainable in the Mason device. The adjustability is intended to set the mechanism to control at different selected temperatures just as the household thermostat can be set manually, for example, at 65, 70, 75 degrees. *It takes no part in the operation of the combination, but, once set, continues unchanged until manually readjusted* (Defdt.'s App. 296, Pat. p. 1, col. 2, lines 53-4).

The last clause of claim 4 of the original (claim 2 of reissue in suit) is merely a functional statement of *adjustability* and does not mention, indicate or describe *any element* by which that function is to be attained.

The fact that a part is made adjustable has never been considered by the courts as constituting a definite or *patentable distinction* over that which is old or even between claims themselves.

In *Marconi Wireless Telegraph Company of America* v. *United States,* 320 U. S. 1, 32, the Court said:

> "The variable inductance imparted no new function to the circuit; and merely making a known element of a known combination adjustable by a means of adjustment known to the art, when no new or unexpected result is obtained, is not invention." (Citing cases.)
>
> "Mere adjustability of parts does not constitute invention." *Smyth Mfg. Co.* v. *Sheridan et al.,* 149 Fed. 208, 211 (C. C. A. 2).

Since "the subject matter" of claim 3 was disclaimed, making that "subject matter" adjustable as in claim 2 of the reissue, did not make it patentable.

> "It involved adjustability only and adjustability is not invention." *Paquette et al.* v. *Potter Mfg. Co.*, 46 F. (2d) 271, 272 (C. C. A. 6).

Upon the above state of facts it is defendant's contention that Mason original patent is invalid for failure to disclaim indistinguishable subject matter, *i.e.* claim 4 of the original (claim 2 of the reissue in suit), when he disclaimed claim 3 of the original; and the reissue is invalid because claim 4, the claim of the original which should have been disclaimed, *came over into the reissue unchanged* as claim 2 in suit, and is still held *in terrorem* over the art. It was relied upon as "typical" by our adversaries, and was sustained in the District Court.

When plaintiff, upon notice from the defendant of certain prior patents, filed its disclaimer on May 11, 1933, giving up the entire subject matter of claim 3 and admitting through Mason that it was not his invention, it was in duty bound to disclaim the patentably indistinguishable claim 4 (claim 2 in suit) and failure to do so brings it under the rule of *Maytag Co.* v. *Hurley Co.*, 307 U. S. 243.

In that case claims 1 and 38 had been disclaimed by plaintiff after an adjudication of their invalidity. But the court held that another claim, 39, not in issue in the prior suit or there, was not patentably distinguishable from those which had been disclaimed. In holding the entire patent invalid for failure to disclaim claim 39, the Supreme Court said:

> "There has been unreasonable neglect or delay in entering a disclaimer of claim 39 within the meaning of R.S. 4917, and R.S. 4922, unless that claim is 'definitely distinguishable from the parts claimed without right',—that is, the disclaimed method claims 1 and 38. This must be so, for the company, by disclaiming those claims, has confessed that the patentee therein claimed 'more than that of which he was the original or first inventor or discoverer' and that the company, as assignee of the patent, therefore, 'did not choose to claim or to hold' the method therein disclosed 'by virtue of the patent or assignment.'" *Maytag Co.* v. *Hurley Co.*, 307 U. S. 243, 245.

The only distinction between the facts in the *Maytag* case and those at bar is that in the former a court had held the disclaimed claims to be invalid, while in the latter the disclaimer was the result of plaintiff's *being convinced by defendant's citation of prior patents* that claim 3 was invalid.

Petitioner, in the Court below, has attempted to distinguish the case at bar from the *Maytag* case on the ground that the disclaimer here was voluntary, but we submit that that is not a proper difference. In fact, it was due to the defendant's calling attention to prior patents.

Besides, the language of the *Maytag* case admits of no such distinction. But the point of asserted distinction was overruled by this Court in *Marconi Co.* v. *U. S.*, 320 U. S. 1, 58; which held that a voluntary disclaimer filed some years after the grant of the patent was too long delayed in view of patentee's knowledge of a certain prior patent, where there had been no decision sustaining that as a defense. In holding the patent invalid the court said:

> "The purpose of the rule that a patent is invalid in its entirety if any part of it be invalid is the pro-

> tection of the public from the threat of an invalid patent, and the purpose of the disclaimer statute is to enable the patentee to relieve himself from the consequences of making an invalid claim *if he is able to show both that the invalid claim was inadvertent and that the disclaimer was made without unreasonable neglect or delay.* * * * Here the patentee has sustained neither burden."

In the instant case the patentee did not merely let the invalid claim remain in the patent as in the *Marconi* case; he deliberately preserved it by *asserting it in the reissue* and in the Courts below as in the *Marconi* case, he "has sustained neither burden".

This is the case which the Court below failed to notice, although it was stressed in our brief to that Court.

We submit that the rule in the *Maytag* case is applicable whether the disclaimer was made as a result of a court holding of invalidity or whether voluntary.

Since

> "Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described." *Ensten* v. *Simon, Asher & Co.*, 282 U. S. 445, 453,

plaintiff's delay has continued for *more than 13 years, i.e.* since *May 11, 1933*, the date of the insufficient disclaimer, until the present time.

6. Indefiniteness of Claims

Petitioner asserts (Pet. p. 6) that "claims 10 and 13 are definite". We say, on the contrary, that petitioner in the Court below, brought in two unnamed elements, in order to distinguish the prior art: The indefiniteness of the claims,

10 and 13, which alone are pressed here, grows in part out of their use of the phrase "control mechanism of the supply and waste valve type". By the specification (Defdt.'s App. 296; patent in suit, col. 1, lines 36-41 and lines 50-55) this undoubtedly refers to the flapper 35 and nozzle 31. That this is true of the specification was asserted in our brief below and not denied. Yet in their brief below our adversaries (at page 14 and elsewhere) referred to a wholly different part—namely "control head 19", which they now call a "relay" valve—as controlling the supply and waste.

Again, neither claim mentions a spring as a part of the so-called motors—39, 53 of the drawings,—nor is it described in the specification. Yet it is asserted in our adversaries' brief below to be a substantive part of both the so-called "proportioning" controller (Pltff.'s Brief below, p. 15) and the so-called "reset" controller of the patent (claim 10 is on the proportioning controller; claim 13 on the reset). As to this element it was found by the trial court that *without it the operation described in the patent could not take place* (Defdt.'s App. 660).

It is these alterations in the claims that are parts of all the devices upon which petitioner relies for its proof of commercial acceptability. They give pertinence to the uncertainty of the claims; indeed, they make of them the traditional "nose of wax".

It should be understood that plaintiff relies on its petition for a review of the *entire* case. But there were pressed upon the court below *all the claims except No. 18*, and a mere perusal of them will show many that are so fulginous as to pass understanding. For example claims 11, 12, 13, 15 and 16 prescribe the "rate of change of condition"; but

what that is, is not set forth in the specification. In claims 19 to 24 means are set forth which are movable in accordance with a "predetermined asymptotic curve"; but that term is not in the specification, and Mason, the patentee, seems to admit that what is disclosed is *not* an asymptotic curve (Defdt.'s App. 656).

Claims 17 to 25 were not in the original patent but were added in the reissue [compare Defdt.'s App. p. 397 with pp. 311-2]. These added claims are, we submit, entirely indefinite. They substitute for distinct statements of the parts of a combination, recitals of "means" and of functions of such means in such involved language as to be practically non-understandable. For that reason they are all invalid under a long line of cases in this Court, from *Brooks et al.* v. *Fiske,* 15 How. (56 U. S.) 212, to *Haliburton Oilwell Cementing Co.* v. *Walker,* decided on November 18, 1946.

Mason was interrogated as to the meaning of the claims, including claim 25, which uses the word "means"—for doing this or that—13 times. He said he would not try to answer that question if the claim used the term but once (Defdt.'s App. 655). That is, the inventor himself had no understanding of the claims of his patent. How, then, could the public apprehend their meaning? Compare *United Carbon Co.* v. *Binney,* 317 U. S. 228, wherein as appears particularly at pages 233 *et seq.,* the patentee gave such interpretation to the claims as to make that which appeared to be definite so uncertain as to vitiate the patent.

All this seems to establish beyond cavil that R. S. Sec. 4888 (35 U. S. C. A. Sec. 33) requiring distinctness of claims, has not been complied with, and the patent is therefore invalid as to all its claims except No. 18 which is not in suit.

General Electric Co. v. *Wabash Electric Co.*, 304 U. S. 364;
Haliburton Oilwell Cementing Co. v. *Walker*, Decided by this Court Nov. 18, 1946.

At page 16 of the Petition, the top full paragraph gives an entirely erroneous impression of the evidence, since it introduces the statement by the sentence that "the success" [of the Mason device] "was directly attributable to *the novel combination claimed.*" The first three references to the record are to witnesses who, so far as appears, had no knowledge whatever of the patent in suit, made no reference to its claims, and were simply describing the utility of the petitioner's devices, which contained the improvements of scores of patents besides the one in issue. So with the series of references to Mason's testimony. He was dealing with the plaintiff's commercial devices, or else with the specification of the patent, or with a Bristol patent, or with one of defendant's instruments, at the pages cited. He made no reference whatever to the claims, and on cross-examination disclaimed all knowledge of them (Pltff.'s App. 655).

It is the fact that the trial Court found that both "proportioning" and "proportioning plus reset" controllers were old (finding 16, Defdt.'s App. 681) but that they were operated by a "*powerful*" measuring element; and (finding No. 17) that none was operable by a "*weak*" measuring element. But neither specification nor claims of Mason describes or is limited to weak or strong elements.

Petitioner is harping upon things not found in the claims; whereas the Court of Appeals compared the *claims* with the prior art, and on that basis found them invalid.

CONCLUSION

We submit that for the foregoing reasons the petition for writ of certiorari should be denied.

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